

**REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed August 13, 2004. Claims 1, 2, 5-10, 13-17, and 20-23 remain pending. Through this response, claims 1, 2, 5-10, 13-17, and 20-23 have been amended, and claims 3, 4, 11, 12, 18, and 19 have been cancelled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims are respectfully requested.

**I. Claim Rejections - 35 U.S.C. § 102(b)**

**A. Statement of the Rejection**

Claims 1-3, 5, 9-11, 17, and 18 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Ishihama, et al.* ("*Ishihama*," U.S. Pat. No. 5,557,328). Applicants respectfully traverse this rejection.

**B. Discussion of the Rejection**

Applicants have amended independent claims 1, 9, and 17 to incorporate features of claims 3, 4 and 10, 11, and 18, 19, respectively. In that independent claims 1, 9, and 17 have been amended to incorporate features not present in the *Ishihama* reference (as acknowledged under section 4 of the Office Action), Applicants submit that the rejection to claims 1, 9, and 17 and their corresponding dependent claims under 35 U.S.C. § 102(b) have been rendered moot. Thus, Applicants will address the patentability of amended independent claims 1, 9, and 17 and their corresponding dependent claims under section II below.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Rejection of Claims**

Claims 4, 6-8, 12-16, and 19-23 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ishihama* in view of *Weldy, et al.* (“*Weldy*,” Pat. No. EP0858208). Applicants respectfully traverse this rejection. Claims 4, 12, and 19 have been cancelled, and their corresponding limitations are incorporated into independent claims 1, 9, and 17, respectively. Thus, through the discussion of independent claims 1, 9, and 17, Applicants will address the rejections to the dependent claims.

### **B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

Further, it has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of merging two captured image

views having different perspectives of a scene and displaying the merged image for the purpose of improving the spatial resolution, and then to crop the displayed image to improve the ability of a viewfinder to distinguish between what portion of a magnified image is to be recorded on a medium. Applicants submit that these distinct and diverse functions are the result of a proposed combination of *Ishihama* and *Weldy*, and thus this proposed combination is improper.

### **Independent Claim 1**

With regard to independent claim 1, Applicants claim (with emphasis added):

1. A digital camera, comprising:  
means for capturing at least two images of a scene, the at least two images including different views of the scene;  
*means for merging the at least two captured images;*  
*means for displaying the merged image;*  
*means for cropping the displayed image;* and  
*means for storing an uncropped portion of the displayed image.*

As acknowledged by the Office Action, *Ishihama* fails to disclose, teach, or suggest at least “means for merging the at least two captured images,” and “means for displaying the merged image,” as recited in claim 1. *Weldy*, on the other hand, fails to disclose, teach, or suggest “means for cropping the displayed image,” and “means for storing an uncropped portion of the displayed image,” also as recited in independent claim 1. The Office Action alleges with regard to the proposed combination of *Ishihama* and *Weldy*:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have been motivated to modify *Ishihama et al.*, US 5,557,328, in view of *Weldy et al.*, EP 0858208, to have means for merging the two captured images into the displayed image in order to overcome the spatial resolution and noise problems with small electronic sensors.

Applicants respectfully disagree, and in particular, submit that the proposed combination of *Ishihama* and *Weldy* is improper since there is no motivation to combine *Weldy* with

*Ishihama*. *Ishihama* is concerned with distinguishing in a viewfinder of a video camera a zoomed-in portion of an image that is to be recorded on a medium with peripheral or outlying areas of the zoomed image that are not to be recorded on the medium. There is no suggestion in the specification in *Ishihama* to add a second lens or take two or more views of an image, or merge the captured views. Further, since there is no concern of spatial resolution or noise even mentioned in *Ishihama*, there does not appear to be a need to capture two or more image views or merge the same. The viewfinder in *Ishihama* simply needs a mechanism to assist a user in determining what portion of the captured and magnified image is going to be recorded on a medium. *Weldy* appears to be concerned with overcoming spatial resolution problems and noise problems. These diverse functions address different issues, *Weldy* improving the quality of the captured image, *Ishihama* assisting the user to determine what portion of an image will be recorded.

Thus, since neither reference alone includes all the features of claim 1, and since the proposed combination is improper, Applicants respectfully request that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over *Ishihama* and *Weldy*, corresponding dependent claims 2 and 5-8 are allowable as a matter of law for at least the reason that dependent claims 2 and 5-8 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

#### **Independent Claim 9**

With regard to independent claim 9, Applicants claim (with emphasis added):

9. A method of controlling the operation of a digital camera, comprising the steps of:  
receiving at least two captured images representing different image views of a scene from a photosensor;  
***merging the at least two captured images;***  
***displaying the merged image;***  
***receiving cropping instructions for the displayed image;***  
***storing an uncropped portion of the displayed image.***

The *Ishihama* reference fails to disclose, teach, or suggest at least “merging the at least two captured images,” and “displaying the merged image,” as recited in claim 9. *Weldy*, on the other hand, fails to disclose, teach, or suggest “receiving cropping instructions for the displayed image,” and “storing an uncropped portion of the displayed image,” also as recited in independent claim 9. Applicants respectfully submit that the proposed combination of *Ishihama* and *Weldy* is improper since there is no motivation to combine *Weldy* with *Ishihama*. There is no suggestion in the specification of *Ishihama* to add a second lens or take two or more views of an image, or merge the captured views. Further, since there is no concern of spatial resolution or noise even mentioned in *Ishihama*, there does not appear to be a need to capture two or more image views or merge the same. *Weldy* appears to be concerned with overcoming spatial resolution problems and noise problems. These diverse functions address different issues, *Weldy* improving the quality of the captured image, *Ishihama* assisting the user to determine what portion of an image will be recorded.

Thus, since neither reference alone includes all the features of claim 9, and since the proposed combination is improper, Applicants respectfully request that the rejection to claim 9 be withdrawn.

Because independent claim 9 is allowable over *Ishihama* and *Weldy*, corresponding dependent claims 10 and 13-16 are allowable as a matter of law.

### Independent Claim 17

With regard to independent claim 17, Applicants claim the following (with emphasis added):

17. A computer readable medium for controlling the operation of a digital camera, comprising:

logic that receives at least two captured images from a photosensor, the at least two captured images corresponding to two different image views of a scene;

*logic that merges the at least two captured images;*

*logic that displays the merged image;*

*logic that receives cropping instructions for the displayed image;*

*logic that stores an uncropped portion of the displayed image;*

*and*

*logic that deletes a cropped portion of the displayed image prior to storing the uncropped portion of the displayed image.*

The *Ishihama* reference fails to disclose, teach, or suggest at least “logic that merges the at least two captured images,” and “logic that displays the merged image,” as recited in claim 17. *Weldy*, on the other hand, fails to disclose, teach, or suggest “logic that receives cropping instructions for the displayed image,” “logic that stores an uncropped portion of the displayed image,” and “logic that deletes a cropped portion of the displayed image prior to storing the uncropped portion of the displayed image,” also as recited in independent claim 17. Applicants respectfully submit that the proposed combination of *Ishihama* and *Weldy* is improper since there is no motivation to combine *Weldy* with *Ishihama*. There is no suggestion in the specification of *Ishihama* to add a second lens or take two or more views of an image, or merge the captured views. Further, since there is no concern of spatial resolution or noise even mentioned in *Ishihama*, there does not appear to be a need to capture two or more image views or merge the same. *Weldy* appears to be concerned with overcoming spatial resolution problems and noise problems. These diverse functions address different issues, *Weldy*

improving the quality of the captured image, *Ishihama* assisting the user to determine what portion of an image will be recorded.

Thus, since neither reference alone includes all the features of claim 17, and since the proposed combination is improper, Applicants respectfully request that the rejection to claim 17 be withdrawn.

Because independent claim 17 is allowable over *Ishihama* and *Weldy*, corresponding dependent claims 20-23 are allowable as a matter of law.

In summary, it is Applicants' position that a proper case for obviousness has not been made against Applicants' independent claims 1, 9, and 17, or corresponding dependent claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Ishihama* and *Weldy* and that the rejection of these claims should be withdrawn.

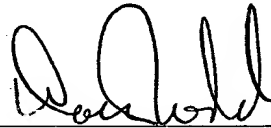
### **III. Cancelled Claims**

As identified above, claims 2, 3, 10, 11, 18, and 19 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Rodack', written over a horizontal line.

**David Rodack**  
**Registration No. 47,034**